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**This Opinion is Not
Citable as Precedent
of the TTAB**

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re LJ Business Services, Inc.

Serial No. 76196140

Richard M. Moose of Dority & Manning for LJ Business Services, Inc.

Catherine Pace Cain, Trademark Examining Attorney, Law Office 113 (Odette Bonnet, Managing Attorney).

Before Hohein, Bottorff and Rogers,
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

LJ Business Services, Inc. [applicant] has applied to register, on the Principal Register, INSTALLATION PROFESSIONALS OF NORTH AMERICA as a service mark for "retail business renovation upfit and remodeling services, namely, constructing retail displays; fixture renovations, namely, fixture remodeling, assembly and placement of fixtures; sign and graphic placements; millwork retrofits, namely, carpentry services; custom construction and

building renovation, namely, complete store buildouts; and merchandise assistance, namely, construction planning regarding fixtures usage and stocking distribution and fulfillment requirements," in Class 37. The application is based on applicant's stated intent to use the mark in commerce in connection with the identified services.

The examining attorney has refused registration under Section 2(e)(2) of the Trademark Act, 15 U.S.C. § 1052(e)(2), on the grounds that the designation applicant seeks to register as a mark is primarily geographically descriptive. Specifically, the examining attorney contends that "OF NORTH AMERICA" will be perceived "clearly and only" as "geographic in significance." Brief, p. 4. She also contends that INSTALLATION PROFESSIONALS is descriptive when used in connection with the identified services, and the "addition of highly descriptive wording to a geographic term does not obviate a determination of geographic descriptiveness." Brief, p. 5.

Applicant's argument in support of registration primarily contends that the examining attorney has failed to consider the mark as a whole, focusing instead on the OF NORTH AMERICA portion to reach a determination of geographic descriptiveness. Brief, pp. 8-9. In addition, applicant contends that INSTALLATION is neither generic nor

descriptive¹ and is in fact suggestive of its services, so that the mark as a whole is suggestive and registrable with the disclaimers applicant has offered for the terms PROFESSIONALS and NORTH AMERICA.² Brief, pp. 2, 9-10.

When the refusal was made final, applicant appealed. A new examining attorney assigned to the application subsequently requested and was granted a remand to introduce additional evidence. After resumption of the appeal, applicant did not, though it was offered the opportunity, submit a supplemental brief. The examining attorney then filed her brief. Oral argument was not requested.

Applicant and the examining attorney agree that a prima facie case for refusal of registration under Section 2(e)(2) requires a showing that the primary significance of the mark is geographic; that prospective purchasers of the

¹ The first examining attorney to examine the application issued the first and second [the final] Office actions. In each action, he asserted both that INSTALLATION PROFESSIONALS was generic and descriptive. The application was then reassigned to a new examining attorney, who obtained a remand of the file to enter additional evidence. The second examining attorney has asserted that INSTALLATION PROFESSIONALS is only highly descriptive. Brief, pp. 5-6.

² While applicant offered these disclaimers in response to the first Office action, the examining attorney did not accept the offer and the disclaimers were not entered. In view of our decision affirming the refusal of registration, there is no need to further consider applicant's offer to disclaim these terms.

goods or services would be likely to make a goods/place association, i.e., would think that the goods or services originate in the place identified in the mark; and that the geographic term in the mark in fact identifies the place of origin of the goods or services. See authorities collected in TMEP Section 1210, acknowledged by both applicant and the examining attorney. It is, of course, the examining attorney's burden to make out the prima facie case in support of the refusal.

To make out her case, the examining attorney relies on a dictionary definition of NORTH AMERICA as designating the northern continent of the western hemisphere; a request in her brief that we take judicial notice of definitions of INSTALLATION as meaning "the act of installing" or "to set in position or connect or adjust for use" and of PROFESSIONAL as meaning "performed by persons receiving pay";³ and information regarding numerous registrations issued by the Office for marks containing the phrase OF NORTH AMERICA and which are preceded by other terms, with each registration being on the Supplemental Register, or on the Principal register either subject to a claim of acquired distinctiveness under Section 2(f) of the

³ We grant the examining attorney's request that we take judicial notice of these definitions.

Trademark Act or with a disclaimer including NORTH AMERICA. The only other material of record is a page from a dictionary, introduced by applicant, showing definitions for "install" and "installation."

We begin by noting applicant's argument that the examining attorney has not considered its mark as a whole. While registrability of a designation as a mark must be based on consideration of the whole, there is nothing improper in considering the plain meanings of the component parts, so long as allowance is made for possible alterations or changes in meaning when the parts are combined into a composite. In re Hester Industries, Inc., 230 USPQ 797, 798 n.5 (TTAB 1986) ("perfectly acceptable to separate a compound mark and discuss the implications of each part thereof ... provided that the ultimate determination is made on the basis of the mark in its entirety"). Thus, under such an approach, if consideration of the mark as a whole reveals that the meaning of terms may have changed as a result of the combination, for example by creation of an ambiguity or incongruity, then a distinctive mark may result.

We agree with the examining attorney that, as employed in INSTALLATION PROFESSIONALS OF NORTH AMERICA, the term NORTH AMERICA has a geographic meaning, and that the use of

the term OF prior thereto reinforces the geographic meaning. We do not find persuasive applicant's argument that OF NORTH AMERICA has a connotation, in this context, of high quality or excellence. See North American Aircoach Systems, Inc. v. North American Aviation, Inc., 231 F.2d 205, 107 USPQ 68 (9th Cir. 1955) (NORTH AMERICAN a term with a geographic connotation but protectible by plaintiff because of showing of secondary meaning), cert. denied, 351 U.S. 920, 109 USPQ 517 (1956). As for the term INSTALLATION PROFESSIONALS, based on the proffered dictionary definitions, as well as applicant's stated willingness to disclaim the term PROFESSIONALS, we agree with the examining attorney's conclusion that these two words describe applicant and its employees, i.e. that they are professionals who install items for retail stores to facilitate operation of their businesses. We do not find persuasive applicant's argument that INSTALLATION is only suggestive when considered in conjunction with applicant's identified services. Nor are we persuaded that when the designation is considered as a whole, the geographic significance of OF NORTH AMERICA or the descriptive significance of INSTALLATION PROFESSIONALS is lost or altered.

The fact that the geographic term in applicant's designation is at the end rather than the beginning does not preclude it from being found geographically descriptive, as evidenced by the numerous registrations of record for marks in the form _____ OF NORTH AMERICA, wherein no exclusive rights were obtained in the geographic designation. See also, In re Monograms America Inc., 51 USPQ2d 1317, 1319-20 (TTAB 1999) (Board rejected applicant's contention that MONOGRAMS AMERICA was registrable as combination of suggestive term [MONOGRAMS] and term implying high quality or excellence [AMERICA], finding composite instead to be combination of highly descriptive term and geographic term; Board therefore affirmed refusal of registration under Section 2(e)(2)); and In re BankAmerica Corporation, 231 USPQ 873, 875 (TTAB 1986) (appropriate refusal to register BANK OF AMERICA for computerized financial data processing services is geographic descriptiveness, not mere descriptiveness; alternative refusal under Section 2(e)(2) affirmed on grounds BANK OF AMERICA primarily signifies an American bank).

Applicant is located in the United States, i.e., within the continent of North America. Therefore, an association of applicant's services and the place named in

INSTALLATION PROFESSIONALS OF NORTH AMERICA will be presumed. In re California Pizza Kitchen Inc., 10 USPQ2d 1704 (TTAB 1988) and In re Handler Fenton Westerns, Inc., 214 USPQ 848 (TTAB 1982). Indeed, applicant has provided no explanation why its prospective customers would not make the association.

Decision: The refusal under Section 2(e)(2) of the Trademark Act is affirmed.